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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/643,120
Filing Date: August 18, 2003
Appellant(s): SPROGIS, DAVID H.

William E. Hilton
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/16/2008 appealing from the Office action mailed 5/1/2008. Additionally, this is in response to the Director ordered remand under 37 CFR 41.35(c) from the Board of Patent Appeals and Interferences mailed 5/25/10.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct with the addition of the New Ground of Rejection discussed below:

NEW GROUND(S) OF REJECTION

Claim(s) 5-8 are rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,141,530	RABOWSKY	10-2000
6,698,020	ZIGMOND et al	2-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabowsky (6,141,530) in view of Zigmond et al (6,698,020)

Regarding claims 1, 3, 5, 7, 8, Rabowsky discloses a system and method for providing advertisement information to an audience. In particular, Rabowsky teaches that cinema files are digitized and distributed to theaters electronically for playback. A automated scheduling system is provided in order to automatically play selected advertising with the actual timed movie showings as an assembled presentation [abstract, 1:61 to 2:5, 7:37-49, 12:8-29]. Rabowsky is taken to provide an enabling

disclosure for compiling and assembling a presentation data package (ads + movie) at the headend. Rabowsky states the ability to request headend changes such as insertion of ads targeted to the theater location, yet it is not clear whether the targeted ads are manually or automatically selected and compiled. While Rabowsky teaches the ability to compile a collection of scheduled ads and the movie for each showing, he does not teach how and which particular ads are chosen for inclusion into the compiled presentation data package. While Rabowsky's movie advertising schedule is clearly automated in terms of playback, he lacks specific teachings for automating the selection of scheduled ads; it is unclear how the ads are chosen for inclusion in the schedule. Zigmond et al teaches a system where video programming is provided with selected targeted advertising. Zigmond et al teaches that conventional prior art systems choose targeted ads based upon location [2:40-43] and that targeted ads can also be selected based upon the content of the video programming, location of the showing, characteristics of the viewer, local time, etc. and then subsequently displayed at the appropriate time [4:25-48]. This selection is accomplished by automatically comparing criteria (that has been entered/input and stored) regarding the audience, showing location and matching that with (input and stored) advertisement metadata/criteria representing the type of audience, type of location, etc. desired by each stored advertisement submitted by the advertiser [col 10-12]. This provides a system whereby job requests are submitted and the system automatically selects appropriately targeted ads for each movie showing. It would have been obvious to one of ordinary skill at the time of the invention to have created the advertising schedule of Rabowsky using

similar techniques (matching stored context metadata concerning the movie content, its showing location and time with stored metadata describing each stored advertisement) so that an appropriate subset of the advertisement collection can be associated and compiled with each actual movie showings. This would provide a more compelling advertisement experience likely to be more well received by the audience than untargeted ads, and would provide a system whereby administrators only need to specify targeting parameters/context/metadata rather than manually build each presentation data package for every movie showing. Rabowsky further discloses that the scheduling system includes scheduling and playout of all trailers and data files (e.g. advertisements)(col 12, lines 8-28). While it is not explicitly disclosed that more than one job request is associated with an actual movie showing, nor that more than one actual movie showing is associated with a job request, Official Notice is taken that it is old and well known for theaters having plural projectors to display a plurality of advertisements and trailers while the audience is waiting for each projector/theater's actual movie showing to start. Likewise, it is old and well known that theaters present many of the same advertisements (e.g. advertising the theater's concession stand) and trailers to audiences awaiting the start of different actual movie showings. Therefore, it would have been obvious to one having ordinary skill in the art to select a plurality of job request for each actual movie showing for each of a plurality of projectors/theaters and to select a plurality of actual movie showings for each job request in Rabowsky. One would have been motivated to select more than one advertisement per actual movie showing in order to keep the audience entertained for the 5-30 minutes they are

awaiting the start of the actual movie showing. One would have been motivated to select more than one actual movie showing per job request in order to preclude the need to make unique advertisements and trailers for every possible actual movie showing. In other words, there would only need to be one advertisement for the theater's concession stand, not a unique one for each actual movie showing. Official Notice is taken that it is common within the movie industry to present the advertisements, trailers, previews, etc. before showing the actual movie. This is done to ensure that the greatest number of people view this information since many people will leave the theater as soon as the movie credits begin to roll at the end of the movie. It also would make no business sense to display an advertisement for the theater's concession stand at the end of the movie. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to display the non-cinema data *in advance* of the movie showing. One would have been motivated to do this for the reasons discussed above.

Regarding claims 2, 6, it would have been obvious to one of ordinary skill at the time of the invention to have automatically assembled the advertisements with consideration for duration parameters, so that the system does not create an endless, nearly endless, or overly-lengthy advertising prior to the movie. No cinema with and business sense would provide hours of advertising prior to the movie showing; therefore it would have been obvious to one of ordinary skill at the time of the invention to have set time limits for the entirety of the ads by restricting a summation of each ad duration.

Regarding claim 4, Official Notice is taken that users are typically notified that requests submitted to a computer system have been properly received. It would have been obvious to one of ordinary skill at the time of the invention to have notified the job-requesting users that their requests have been properly received by the system so that the users can be confident the requests were not lost or malformed.

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim(s) 5-8 are rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5 and 8 recite the following means (or step) plus function limitation:

projector control means configured to present said first presentation data using said first projector assembly such that said first subset of content data will be shown prior to a first start time associated with said first show, and configured to present said second presentation data using said second projector assembly such that said second subset of content data will be show prior to a second start time associated with said second show

This limitation invokes 35 USC § 112, ¶ 6 because it meets the 3-prong analysis set forth in MPEP 2181 as it recites the phrase “means for” or “step for” (or appellant

identifies the limitation as a means (or step) plus function limitation in the appeal brief) and the phrase is modified by functional language and it is not modified by sufficient structure, material, or acts for performing the recited function. Also see *Altiris Inc. v. Semantec Corp.*, 318 F.3d 1363, 1375 (Fed. Cir. 2003). 35 USC § 112, ¶ 6, requires such claim to be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. “If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section § 112.” In *re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ 1845, 1850 (Fed. Cir. 1994)(in banc.). For a computer-implemented means-plus-function claim limitation that invokes 35 USC § 112, ¶ 6, the corresponding structure is required to be more than simply a general purpose computer. *Aristocrat Technologies, Inc. v. International Game Technology*, 521 F.3d 1328, 1333, 86 USPQ2d 1235, 1239-40 (Fed. Cir. 2008). The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer. *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). The written description must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the claimed function. *Aristocrat*, 521 F.3d at 1338, 86 USPQ2d at 1242.

In the instant application, the following portions of the specification and drawings may appear to describe the corresponding structure for performing the claimed function:

Figure 2 depicts personal computer 34.

Figure 4 depicts PC 50.

Page 17, lines 20-24 recite that client assembly 30 includes PC 34 that is connected to system's intranet 32 via connection port 40 through which it receives presentations, and that assembly 30 also includes digital projector 36 through which PC 34 renders presentations on theatre screen 42.

Page 18, lines 21-22 recite that each client assembly 44 includes PC 50 that may be any general purpose small-scale computer capable of running the required software.

However, the specification and drawings do not disclose sufficient corresponding structure, material or acts for performing the claimed function. It appears that projector 36 is controlled by PC 34, 50. However, the specification admits that PC 34, 50 are general purpose PCs, and does not describe how PC 34, 50 controls projector 36. Specifically, the specification does not provide the algorithm for the claimed means for controlling projector 36. As such, Appellant has failed to adequately describe sufficient structure for performing the functions claimed.

(10) Response to Argument

Applicant argues that there is no disclosure how the trailer is compiled at the headend. It is clear from Rabowsky that a collection of ads is chosen for a particular movie showing and that the proper cinema files are delivered to the proper movie projector for playback pursuant to the schedule. Applicant recognizes that a

schedule is created at the headend, but notes that a theater operator may make modifications. Abilities to modify are not taken to be incongruous with examiner's rejection.

Applicant argues that Rabowsky compiles the trailer at the headend, but does not teach how the trailer is compiled. Applicant points out that the invention includes accessing information responsive to two sets of information (context data and show schedule) as well as assembly of the presentation data. The rejection contemplates a modified system which automatically selects a subset of ads according to several (i.e. two sets of information) matching criteria. Examiner has included a more detailed description of the basis for the rejection as follows regarding these two points:

Rabowsky is taken to provide an enabling disclosure for compiling and assembling a presentation data package (ads + movie) at the headend. Rabowsky states the ability to request headend changes such as insertion of ads targeted to the theater location, yet it is not clear whether the targeted ads are manually or automatically selected and compiled. While Rabowsky teaches the ability to compile a collection of scheduled ads and the movie for each showing, he does not teach how and which particular ads are chosen for inclusion into the compiled presentation data package. While Rabowsky's movie advertising schedule is clearly automated in terms of playback, he lacks specific teachings for automating the selection of scheduled ads; it is unclear how the ads are chosen for inclusion in the schedule. Zigmond et al teaches a system where video programming is provided with selected targeted advertising. Zigmond et al teaches that conventional prior art systems choose targeted ads based upon location [2:40-43] and that targeted ads can also be selected based upon the content of the video programming, location of the showing, characteristics of the

viewer, local time, etc. and then subsequently displayed at the appropriate time [4:25-48]. This selection is accomplished by automatically comparing criteria (that has been entered/input and stored) regarding the audience, showing location and matching that with (input and stored) advertisement metadata/criteria representing the type of audience, type of location, etc. desired by each stored advertisement submitted by the advertiser [col 10-12]. This provides a system whereby job requests are submitted and the system automatically selects appropriately targeted ads for each movie showing. It would have been obvious to one of ordinary skill at the time of the invention to have created the advertising schedule of Rabowsky using similar techniques (matching stored context metadata concerning the movie content, its showing location and time with stored metadata describing each stored advertisement) so that an appropriate subset of the advertisement collection can be associated and compiled with each actual movie showings. This would provide a more compelling advertisement experience likely to be more well received by the audience than untargeted ads, and would provide a system whereby administrators only need to specify targeting parameters/context/metadata rather than manually build each presentation data package for every movie showing.

Applicant argues that because Rabowsky discloses its schedule of movies must be “authorized” [col 2 lines 2-3], the schedule of movies is not disclosed to be automated. To provide context, the portion relied upon in applicant’s arguments includes:

an **automation/scheduling** system which **directs playback of cinema files** in the secure projector systems **as authorized by the management system** [col 1: line 67 to col 2: line 3].

This is the automated *playback* of the schedule that has already been created at the headend. The created schedule defines the cinema files to be shown. The cinema files are described here as “authorized” simply because they have been included in

a schedule. Files/content not in the schedule are *not authorized* to be played. In other words the schedule itself *IS* the authorization. Nonetheless it is Rabowsky's above-quoted "management system" which creates (read: authorizes) a schedule of cinema files to be played. The examiner essentially agrees that Rabowsky's scheduling process may not be an automated one – but not because Rabowsky's describes scheduled content as "authorized", but because there is not enough disclosure to be certain of any automation on the task of choosing cinema files to be part of the schedule. This is why the rejection is one of obviousness in view of Zigmond et al. It is also important to note that Rabowsky does clearly teach *automated playback* of that which is scheduled/authorized.

Applicant notes that Rabowsky allows for manual insertion of ads into a schedule, however this is not believed to be a proper teaching away from automating a schedule as suggested by Zigmond et al. In fact allowing for automation would be seen as an enhancement to Rabowsky rather than a "frustration of the principles of operation" as applicant argues. Indeed even an automated scheduling system could allow for manual changes or insertions; the two are not mutually exclusive. Further, known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art [KSR rationale F; *Leapfrog Enterprises, Inc. v. Fisher-Price*, 485 F.3d 1157, 82 USPQ2d 1687 (Fed. Cir. 2007)]. One of ordinary skill in the art of advertising would have found it obvious to update the

assumed-to-be-manual selection of ads for inclusion in Rabowsky's pre-movie advertising schedule using automated matching techniques so as to create an automated and targeted set of ads relevant to the movie showing, thus gaining the commonly understood benefits of such automation - such as speed, accuracy and ease of ad selection/scheduling. All this would be accomplished with no unpredictable results.

Applicant argues that Zigmond et al does not teach a "schedule of ads", yet he classifies Zigmond et al as "selecting individual ads for specific time allocated spots in a programming feed" which sounds like a schedule of ads to the examiner. However, Examiner notes that Rabowsky already clearly has the desire for a schedule of ads, but is turning to Zigmond et al for teachings on how to automate *selection* of ads for scheduled playback. Applicant argues that "selecting individual ads for specific time allocated spots in a programming feed" is not the same as creating a schedule of targeted ads, which is a far more complex undertaking." The particular number of ads to choose for a single advertising period is not seen as a terribly complex aspect, and is not seen as non-obvious or beyond one of ordinary skill.

Applicant argues that such a combined system would still not achieve the functionality of [the claims], yet there is no discussion what functionality or claim limitations in particular have been unaddressed or not fully addressed. Applicant makes further sweeping statements that "any modification" of Rabowsky would be contrary to the teachings of Rabowsky and would require substantial impermissible

redesign. Here applicant fails to focus on the *particular* modifications proposed by the examiner and fails to provide particular reasoning *why* “substantial impermissible” redesign would be not only necessary, but beyond the abilities of one having ordinary skill.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner’s answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the

other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Jeffrey D. Carlson/
Primary Examiner, Art Unit 3622

Conferees:

Eric Stamber/E. W. S./
Supervisory Patent Examiner, Art Unit 3622

Vincent Millin /vm/
Appeals Conference Specialist

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/
Director, TC 3600